



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,223	11/27/2001	Jennifer L. Hillman	PF-0425-1 DIV	4146

27904 7590 07/02/2003

INCYTE CORPORATION (formerly known as Incyte
Genomics, Inc.)
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER

UNGAR, SUSAN NMN

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 07/02/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/996,223

Applicant(s)
Hillman et al

Examiner
Ungar

Art Unit
1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 27, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 11, 17, 18, 20, 23, 26, 27, 30-32, and 34-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1, 2, 11, 17, 18, 20, 23, 26, 27, 30-32, and 34-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1642

1. Claims 1-2, 11, 17-18, 20, 23, 26-27, 30-32, 34-45 are pending in the application and are currently under prosecution.

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Anthony Caputa, Ph.D., Supervisory Patent Examiner at 703-308-3995. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group 1. Claims 1, 2, 17-18 are drawn to a purified polypeptide classified in Class 530, subclass 300+.

Group 2. Claims 11, 32, 34, 37-38, 40-43 are drawn to an isolated antibody classified in Class 530, subclass 387.1.

Group 3. Claim 20 is drawn to a method for screening an agonist classified in Class 435, subclass 4.

Group 4. Claim 23 is drawn to a method for screening an antagonist classified in Class 435, subclass 4.

Group 5. Claim 26 is drawn to a method for screening a binder classified in Class 435, subclass 4.

Group 6. Claim 27 is drawn to a method for screening a modulator classified in Class 435, subclass 4.

Art Unit: 1642

Group 7. Claims 30-31 are drawn to a method for *in vitro* diagnostic testing classified in Class 435, subclass 7.1.

Group 8. Claims 30-31 and 35 are drawn to a method for *in vivo* diagnostic testing classified in Class 424, subclass 130.1.

Group 9. Claim 36 is drawn to a method of preparing a polyclonal antibody classified in Class 530, subclass 389.1.

Group 10. Claim 39 is drawn to a method of preparing a monoclonal antibody classified in Class 530, subclass 389.1.

Group 11. Claim 44 is drawn to a method of detecting a polypeptide with an antibody classified in Class 435, subclass 7.1.

Group 12. Claim 45 is drawn to a method of detecting a polypeptide with an antibody classified in Class 435, subclass 7.1.

Group 13. Claim 45 is drawn to a method of purifying a polypeptide with an antibody classified in Class 435, subclass 7.1.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions 1-2 as disclosed are biologically and chemically distinct, unrelated in structure and function, made by and used in different methods and are therefore distinct inventions.

Inventions 3-13 are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

Art Unit: 1642

The inventions of Groups 1 and 3-8 and 11-13 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the antibody product as claimed and the polypeptide as claimed can each be used in a materially different process such as an antigen to producing antibodies.

The inventions of Groups 1 and 9/10 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the peptide product as claimed can each be used in a materially different process such as an affinity chromatography.

The inventions of Groups 2 and 3-8 and 11-13 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the antibody product as claimed can each be used in a materially different process such as being the antigen to produce anti-idiotypic antibodies.

Inventions 9/10 and 2 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the antibody product can be made by machine automated synthesis of the protein.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner

Art Unit: 1642

to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

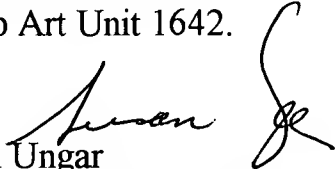
7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.


Susan Ungar
Primary Patent Examiner
January 24, 2003